

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	Examiner: Thomas A. Morrison
Andersen et al.)	
)	Art Unit: 3653
Serial No.: 10/627,560)	
)	
Filed: July 25, 2003)	
)	
For: SYSTEM AND METHOD FOR)	
HANDLING PRINT MEDIA)	
)	
)	Attorney Docket No.:
)	200209473-1
)	

August 3, 2009

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO REMAND ORDER

Dear Sir:

This Reply is provided in response to the “Order Remanding To The Examiner” dated February 11, 2008 (hereinafter “Remand Order”) and the follow-up Remand Order dated November 13, 2008 requiring the examiner to address the Remand Order.

Reply to Remand Order

The Board of Patent Appeals (the "Board") issued the Remand Order to the Examiner under 37 CFR 41.50(a)(1) on February 11, 2008 to consider and address a number of questions. The Board then issued a second Remand Order on November 13, 2008 since no response was yet received from the examiner.

In the Remand Order, The Appellant was also invited to address the questions (Remand Order, page 4). Since the examiner has not yet provided a response, Appellant submits the present reply to address the questions and to advance the appeal process.

Question 1: (A) Whether the path from Stemmler's tray 83 to rollers 88 is part of the primary media path and, if so, **(B)** whether the primary media path and the duplex media path, as those terms are used by the Appellants, can overlap?

(A) Answer: No. The path from Stemmler's tray 83 to rollers 88 is an additional input path that inputs paper to the primary media path. This is an optional paper path from the optional paper tray 83 that leads to the primary media path through rollers 88. Thus, the path in question is not part of the primary media path or the duplex path of the inverter 40.

The paper path between tray 83 and rollers 88 is clearly separate from the duplex paper path of the inverter 40. In fact, the duplex path from the inverter 40 is shown to exit into the paper path of the paper tray 83. Thus the paper from duplex path of the inverter 40 becomes the input into the paper path of the paper tray 83. For example, see the angle of exit point from inverter 40 shown in Stemmler's figure 8 reproduced below. The exit point angles upward and into the paper path of the paper tray 83. Accordingly, the paper tray 83 does not input into the duplex path.

Rather, the inverter 40 inputs into the paper path of tray 83. This is opposite of what is claimed. No claim is anticipated.

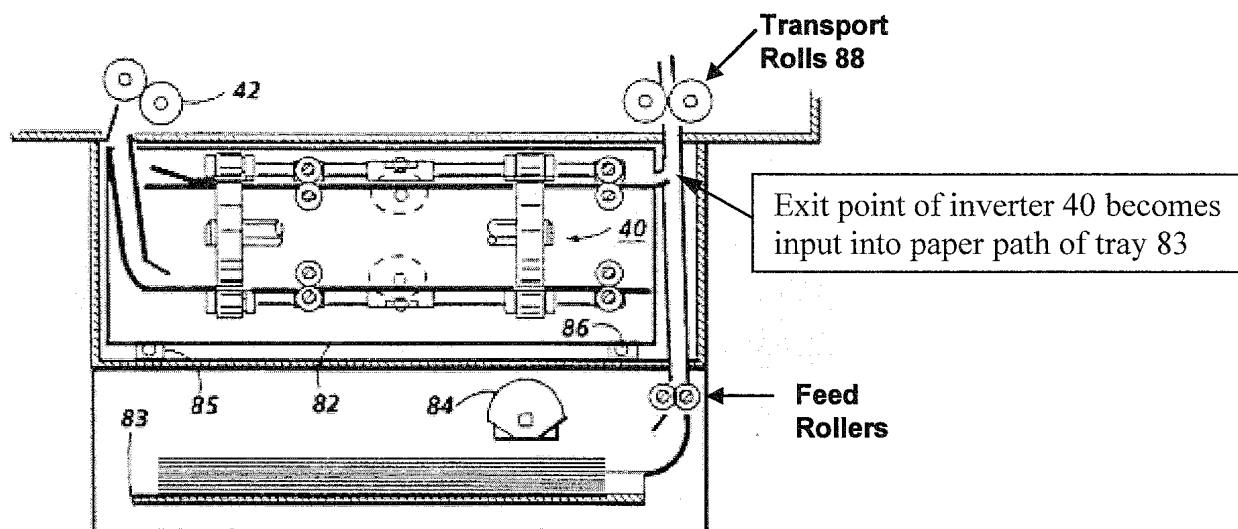


FIG. 8

The primary media path, as used by the Appellant, is the path along which an image is formed/transferred onto the paper. In Appellant's specification, figure 2 shows an example primary media path 210 where primary media storage 220 inputs into the primary media path 210. An image is formed on the paper in the image forming mechanism 215, and the paper is outputted to the output device 240. In Stemmler Figure 1, the primary media path is from the primary media source (support tray 26), through rollers 28, through the transfer station 29, and then outputted through the output rollers 33. Both Stemmler and the present specification show similar configurations of a primary media path.

(B) Can the primary media path and the duplex media paths overlap?
Answer: Stemmler does not discuss overlapping paths. The primary path and the

duplex path could have transition areas where the paper transfers from one path to the other. However, Stemmler fails to discuss where its paths begin and end because Stemmler is not concerned with such teachings. Thus these determinations are only being made by speculation and impermissible hindsight, which fail to rise to the level of anticipation. There is insufficient evidence as to overlapping paths to make an absolute answer of yes or no. Regardless of this point, as explained above, paper from the inverter 40 exits into the paper path of tray 83. Thus paper from the tray 83 is not input into the duplex path of the inverter 40.

Question 2: Whether the Appellant's claim 1 and dependent claims 2-9 encompass Stemmler's feeding of sheets from figure 8's tray 83 to the duplex media path via the primary media path?

Answer: No. Claim 1 explicitly recites, "a media feeder ... to input print media into the duplex media path..." Claim 1 does not recite that the print media is first input into the primary media path, travels through the primary media path, and then is input to the duplex path. Such an interpretation would be ignoring the actual claim language and would be inconsistent with the present specification. Inputting paper into the primary media path fails to teach or suggest inputting paper into the duplex path.

Question 3: Whether, if the path between Stemmler's figure 8's tray 83 and figure 1's rollers 88 is part of the primary media path, and if the primary media path and the duplex media path cannot overlap, Stemmler meets the requirement of the Appellants' claims 10-15 that non-imaged media is input into the return media path, or the requirement of claims 3 and 16-21 that the duplex media path receives non-imaged media.

Answer: Stemmler does not meet the requirement of claims 10-15. The return media path is recited in claim 10 as:

“a return media path configured to selectively receive imaged print media from the primary media path and return the imaged media to the primary media path for multiple imaging”

Therefore since paper tray 83 does not input media into a path that receives imaged print media, Stemmler fails to teach or suggest the claimed media input unit “to input non-imaged media into the return media path.” Rather as explained above, the return media path in Stemmler (e.g. the path of the inverter 40 which receives imaged print media) inputs into the path of the paper tray 83, which is opposite from what is claimed.

Furthermore, claim 10 recites that “the media input unit is positioned where the return media path does not return the imaged media across the media input unit during duplex printing.” If the paper tray 83 of Stemmler figure 8 is read on the claimed media input unit, then figure 8 clearly shows that the inverter 40 does return the image media across the paper tray 83 during duplex printing. Thus Stemmler fails to teach or suggest this element.

Interpretations of Stemmler and Failure to Anticipate

Appellant wishes to thank the Board for the careful review of the present appeal and the initiative to correctly resolve the issues at hand. Appellant would like to respectfully note that the interpretations of Stemmler regarding where the primary path begins/ends, where the duplex path begins/ends, and where paper is exactly inputted are not facts considered or discussed by Stemmler. Stemmler is not concerned with inputting paper into the duplex path and does not discuss such an input feature.

As a result, the examiner as well as the Appellant is now involved in a hindsight interpretation. The claims are being used as a blue print to reconstruct the invention from the figures of Stemmler. Stemmler is also being interpreted in ways

only discussed by the present application. Thus Appellant respectfully submits that the interpretations of Stemmler are only made through impermissible hindsight.

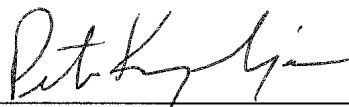
The fact that the claimed features are not apparent from Stemmler should be regarded as a failure to disclose.

Although the present rejection is not an obviousness rejection, MPEP 2145, section X.A., states that, "[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). In the present case, the reasoning applied by the examiner clearly includes knowledge gleaned only from applicant's disclosure. It is only the disclosed features of the present application that are being used in an attempt to somehow find them in Stemmler. No one of ordinary skill upon reading Stemmler at the time of the invention would conclude that Stemmler inputs media into the duplex media path. The claims are not taught or suggested and all rejections should be reversed.

Conclusion

Appellant respectfully maintains all previous arguments, which show the deficiencies in the rejections, along with the additional comments submitted herein. Accordingly, Appellant respectfully requests that the Board of Appeals overturn all rejections and allow all pending claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Kraguljac", is written above a horizontal line.

Peter Kraguljac (Reg. No. 38,520)

(216) 503-5500

Kraguljac & Kalnay LLC
4700 Rockside Road
Summit One, Suite 510
Independence, OH 44131